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In re Application of :
ANDERSON, et al. : DECISION
Application No.: 09/937,232 :
Filing Date: 24 September 2001 :
Attorney Docket No.: P63654USW :
For: VALVE :

This decision is in response to applicants' "Petition under 37 CFR 1.182" filed 01 December 2003 requesting that the above captioned application be treated as a U.S. national stage application.

BACKGROUND

On 23 February 2000, applicants filed international application no. PCT/EP00/01444 which claimed a priority date of 24 March 1999. A Demand was filed with the International Preliminary Examination Authority prior to the 19th month from the earliest claimed priority date. As a result, the deadline for payment of the basic national fee was to expire 30 months from the priority date, or at midnight on 24 September 2001.

On 24 September 2001, applicants filed a Transmittal Letter for entry into the national stage accompanied, *inter alia*, by: the requisite basic national fee; a copy of the international application; a "Preliminary Amendment Under 35 U.S.C. 111"; and an executed declaration.

On 30 October 2001, the United States Designated/Elected Office (DO/EO/US) mailed a "Notification of Acceptance of Application under 35 U.S.C. 371 and 37 CFR 1.494 or 1.495" (Form PCT/DO/EO/903) which set forth a 35 U.S.C. 371 completion date of 24 September 2001.

On 30 July 2002, applicants filed "Petition to Accept an Unintentionally Delayed Priority Claim under 37 C.F.R. 1.78(a)(3)."

On 25 September 2002, the Office PCT Legal Administration mailed "Notification" which indicated that the application was being processed under 35 U.S.C. 111 and vacated the "Notification of Acceptance of Application" mailed 30 October 2001.

On 08 November 2002, applicants filed Petition to Commission for Reconsideration of Decision on Petition of PCT Legal Office under 37 CFR 1.181"

On 22 August 2003, applicants filed a facsimile communication which included a copy of the petition filed 08 November 2002. In a decision dated 30 September 2003, applicants petitions were dismissed without prejudice.

On 01 December 2003, applicants filed the present renewed petition under 37 CFR 1.182.

DISCUSSION

Petitioner is correct in its assertion that the initial papers were treated under 35 U.S.C. 371. However, a submission to enter the national stage must be clearly and unambiguously identified as such. Otherwise, the submission will be treated as being made under 35 U.S.C. 111(a). See 37 CFR 1.495(g)¹ and MPEP section 1893.03(a). Applicant's 24 September 2001 submission included a "Preliminary Amendment Under 35 U.S.C. 111."

Petitioner relies on MPEP section 1893.03(a) which states, "the key indicators which reflect that an application is an application which entered the national stage from an international application after compliance with 35 U.S.C. 371 are: (A) The file indication of 'filed under 35 U.S.C.371'; (B) PALM will indicate that the application is a national stage application; (C) The Form PCT/DO/EO/903 indicating acceptance as a national stage application . . . (D) Applicant's statement (or the equivalent) in the originally filed application papers that the application is a submission to enter the national stage under 35 U.S.C. 371. Applicants who use transmittal Form PCT/DO/EO/1390 will, in the absence of conflicting instructions, satisfy the requirement for such a statement since the form includes an indication that the application is a national stage submission under 35 U.S.C. 371." It is noted that the key indicators, to which petitioner refers to, are not used to determine whether an application is treated under 35 U.S.C. 371 or 35 U.S.C. 111(a), but are used by the examiner to identify the status of an application. Additionally, MPEP section 1893.03(a) states further that, the examiner should (also) inspect wrapper to determine whether an application is filed under 35 U.S.C. 371 or 111(a). In this case, upon inspection of the file wrapper and papers therein, the examiner forwarded the application to the Office of PCT Legal Administration. It was determined that the Preliminary Amendment under 35 U.S.C. 111 was a conflicting instruction. Therefore, applicants' paper deposited on 24 September 2001 should have been treated as a filing under 35 U.S.C. 111(a).

Petitioner also asserts that the alleged reference in the Preliminary Amendment does not qualify as a "conflicting instruction." Although other parts of initial application

¹37 CFR 1.495(g) states: The documents and fees submitted under paragraph (b) and (c) of this section must, except for a copy of the international application or translation of the international application that is identified as provided in section 1.417 be clearly identified as a submission to enter the national stage under 35 U.S.C. 371, otherwise the submission will be considered as being made under 35 U.S.C. 111.

submission identifies an intent to enter the U.S. national stage under 35 U.S.C. 371, such does not change the fact the a conflicting instruction was present in the initial submission. See Section 1893.03(a) of the MPEP, in accordance with Official Gazette at 1077 OG 13 entitled "Minimum Requirements for Acceptance of Applications Under 35 U.S.C. 371 (the National Stage of PCT)" states that:

If there are any conflicting instructions as to whether the filing is under 35 U.S.C. 111(a) or 35 U.S.C. 371, the application will be accepted as filed under 35 U.S.C. 111(a).

In this case, applicants filed a specification listing the international application number, a declaration claiming priority of an international application, and a "Preliminary Amendment Under 35 U.S.C. 111." The filing of the preliminary amendment under 37 U.S.C. 111 is considered a conflicting instruction since the Office is unable to determine whether the application should be treated under 35 U.S.C. 371 or 35 U.S.C. 111(a). Therefore, applicants' paper deposited on 24 September 2001 should have been treated under 35 U.S.C. 111(a).

Additionally, petitioner states that "the final sentence MPEP section 1893.03(a) modifies the above provision determining acceptance of the application as being filed under 35 U.S.C. 371, i.e., 'any conflicting instruction' refers to the instructions with respect to the oath and declaration." Petitioner's assertion is incorrect. Petitioner is directed to the official PTO Notice published in the Official Gazette at 1077 OG 13 entitled "Minimum Requirements for Acceptance of Applications Under 35 U.S.C. 371 (the National Stage of PCT)" which states, in part, the following:

To clearly indicate an international application is being filed under 35 U.S.C. 371 the applicant should use the "Transmittal Letter for United States Designated Office" (Form PTO-1390) as the transmittal letter.

Alternatively, one of the following indications may be used:

1) the applicant shall clearly state in the transmittal or cover letter that he or she is filing under 35 U.S.C. 371 or entering the national stage under PCT; or

2) the applicant clearly identifies in the oath or declaration the specification to which it is directed by referring to a particular international application by PCT Serial Number and International Filing Date and that he or she is executing the declaration as, and seeking a U.S. Patent as, the inventor of the invention described in the identified international application.

Applicants are cautioned that the identification of the international application, in the oath or declaration or otherwise, as a prior filed application for priority purposes is not considered to be an indication of an intention to file under 35 U.S.C. 371.

If there are any conflicting instruction as to which section of the statute (371 or 111) is intended the application will accepted under 35 U.S.C.

111. It is strongly recommended that applicant used the Form PTO-1390 in all cases where a filing under 35 U.S.C. 371 is intended.

Petitioner assertion that the oath or declaration which identifies an international application; PTO's treatment of the application as 35 U.S.C. 371 application; and the mailing of the Notification of Acceptance is an "unqualified acceptance of application" as a national stage application is incorrect. As stated in the "Notification" dated 25 September 2002, upon inspection of the application file, which included a Preliminary Amendment under 35 U.S.C. 111, the "Notification of Acceptance of Application under 35 U.S.C. 371 and 37 CFR 1.494 or 1.495" mailed 30 October 2001 was vacated and applicants were notified that the application would be treated under 35 U.S.C. 111.

A copy of Official Gazette at 1077 OG 13 entitled "Minimum Requirements for Acceptance of Applications Under 35 U.S.C. 371 (the National Stage of PCT)" has been provided for petitioner's convenience.

CONCLUSION

The petition under 37 CFR 1.182 is **DISMISSED** without prejudice.

Any reconsideration on the merits of this petition must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.182."

Any further correspondence with respect to this matter should be addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

This application is being returned to the Technology Center 3754.



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Enclosure: Official Gazette at 1077 OG 13 entitled "Minimum Requirements for Acceptance of Applications Under 35 U.S.C. 371 (the National Stage of PCT)"

